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Lawrence A. Denny

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EXAMINER

ULLAH MASUD, MOHAMMAD R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/722,276	Applicant(s) DENNY, LAWRENCE A.	
	Examiner MOHAMMAD R. ULLAH MASUD	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action responds to the amendment and arguments filed by applicant on October 25, 2010 in reply to the previous Office action on the merits, mailed April 23, 2010.

Prosecution History Summary

- Claims 1 – 24 are pending in the instant application.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The preamble of these recite a method, however the body of these claims do not positively tie the process steps to said apparatus.

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Claims 1, 9, and 17 recite "receiving, via a host system". However, these host systems do not appear to be anything more than website as it recites in paragraph [0023] "For example, the host system 12 can be an internet web site capable of transmitting and receiving information onto a public and/or global network, such as the world wide web". See MPEP § 2106.01.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-13, 16-21, and 23-24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia (US 6,088,429) and further in view of Kobylevsky et al. (US 2005/0060200) (Hereinafter referred to as Kobylevsky).

With respect to **claims 1, 9, and 17**, Garcia discloses a similar method for verifying prescriptions, the method comprising the steps of:

receiving, a set of prescription information authorized by a health care provider from a computer system associated with a health care provider, the set of prescription information including a prescribed drug, and a dosage level for the prescribed drug, a unique health care provider code identifying the health care provider, and a patient code uniquely identifying the patient (see, for example, abstract, column 2 line 52-58; column 9 line 8-21 Garcia discloses "The active profile can describe the patient's diagnosis and treatment plan, including all of the patient's active prescriptions" also in column 7 lines 13 – 17 Garcia discloses "The audio

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communication from the patient contains a unique identifier which can be used as a key to query the database 214 **for a set of one or more prescriptions** identified for the patient in the host system database 214);

generating a unique identification code, via the host system, identifying the set of prescription information (column 3 lines 31-36 discloses generating identification code and column 7 lines 13 – 17, column 13 lines 57 – 61, Garcia discloses “The audio communication from the patient contains a unique identifier which can be used as a key to query the database 214 **for a set of one or more prescriptions identified** for the patient in the host system database 214);

storing the prescription information including the unique identification code identifying the set of prescription information (see, for example, column 3 line 2-20, column 7 lines 13 - 17);

transmitting set of prescription information and the unique identification code to the computer system associated with a health care provider (column 4 lines 7-11 discloses prescription information with the identification code; column 9 line 8-44 discloses the transmission);

receiving, via the host system, the unique identification code from a computer system associated with a pharmacy (see, for example, column 4 line 7-11; column 9 line 8-44); and

transmitting, via the host system, retrieval information identified by the unique identification code to the computer system associated with the pharmacy, the retrieval information including the unique health care provider code identifying the health care provider, the patient code uniquely identifying the patient, and the prescription information identifying the

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prescribed drug and dosage level (see, for example, abstract, column 2 line 52-58; column 9 line 8-21).

Garcia discloses all the above mentioned limitations and also discloses a method for receiving in column 2 lines 52-62, but does not explicitly teach the limitation of receiving, via a host system communicating with the internet.

However, Kobylevsky teaches the limitation of receiving, via a host system communicating with the internet (see, for example, abstract lines 9-12 and figure 1).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Garcia, in accordance with the teaching of Kobylevsky, in order to verify prescriptions, receiving, via a host system communicating with the internet, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

With respect to **claims 3, 11, and 19**, Garcia discloses a similar method, wherein in the step of transmitting the set of prescription information and the unique identification code to the computer system associated with a health care provider, a printed prescription is produced at the health care provider's computer system having the unique identification code (see, for example, column 9 line 12-28, and column 10 line 55-63; column 13 line 11-15).

With respect to **claims 4, 12, and 20**, Garcia discloses a similar method, further comprising the step of outputting a report to a computer associated with a user other than a health care provider or a pharmacy (see, for example, column 10 line 55-67).

With respect to **claims 5, 13, and 21**, Garcia discloses a similar method, wherein the user is associated with a governmental entity (see, for example, column 4 line 7-22).

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With respect to **claims 8, 16, and 24**, Garcia discloses a similar method, further comprising the step of outputting a patient prescription history which includes previous patient prescriptions associated by at least one of a patient code, a health care provider code, and a pharmacy code (see, for example, column 9 line 12-28, and column 10 line 55-63; column 13 line 11-15).

With respect to **Claims 2, 7, 10, 15, 18, and 23** Garcia discloses all the above mentioned limitations and also discloses the prescription identified by the set of prescription information has been filled by the computer system associated with the pharmacy (see, for example, column 7 lines 13-17), but does not explicitly teach the limitation further comprising the step of receiving, by the host system, a confirmation code, and wherein the report is summarized by the name of the prescribing health care provider.

However, with respect to **claims 2, 10, and 18**, Kobylevsky teaches the limitation, further comprising the step of receiving, by the host system, a confirmation code (see, for example, paragraph [0103]), and

with respect to **claims 7, 15, and 23**, Kobylevsky teaches the limitation, wherein the report is summarized by the name of the prescribing health care provider (see, for example, paragraph [0161] here Kobylevsky discloses that orders can be sorted in variety of way).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Garcia, in accordance with the teaching of Kobylevsky, in order to verify prescriptions, further comprising the step of receiving, by the host system, a confirmation code, and wherein the report is summarized by the name of the prescribing health care provider, since so doing could be performed readily and easily by any

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person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

3. Claims 6, 14, and 22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia and Kobylevsky as applied to claims 1, 4, 9, 12, 17, and 20 above, and further in view of Boyer et al. (US 6,202,923).

Garcia and Kobylevsky disclose all the above mentioned limitations, but do not explicitly teach the limitation wherein the user is associated with an insurance company.

However, Boyer et al. teaches the limitation, wherein the user is associated with an insurance company (see, for example, column 6 line 33-44).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Garcia and Kobylevsky, in accordance with the teaching of Boyer et al. in order to, verify prescriptions, wherein the user is associated with an insurance company, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

Applicant's arguments filed on October 25, 2010 have been fully considered but they are not persuasive.

With respect to 35 USC § 101 rejections applicant argues that “Even though the machine-or-transformation test is not the exclusive test for determining patent eligible subject matter, the

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currently pending claims satisfy the machine-or-transformation test because they are tied to a particular machine, e.g., the host system”.

Examiner notes that in paragraph [0023] host system is defined as a website as it recites “For example, the host system 12 can be an internet web site capable of transmitting and receiving information onto a public and/or global network, such as the world wide web”. Please see MPEP § 2106.01.

Applicant argues that “Garcia also does not disclose "generating a unique identification code...identifying the set of prescription information" or "transmitting the set of prescription information and the unique identification code to the computer system associated with the health care provider”.

Examiner notes that column 3 lines 31-36 discloses generating identification code and in column 7 lines 13 – 17, column 13 lines 57 – 61, Garcia discloses “The audio communication from the patient contains a unique identifier which can be used as a key to query the database 214 **for a set of one or more prescriptions identified** for the patient in the host system database 214”.

Examiner also notes that in column 4 lines 7-11 Garcia discloses prescription information with the identification code and column 9 lines 8-44 discloses the transmission.

Examiner notes no other remarks or arguments. Accordingly the rejection remains as is.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD R. ULLAH MASUD whose telephone number is (571)270-5390. The examiner can normally be reached on MONDAY TO THURSDAY 9.00 AM TO 5.30 PM (EASTERN TIME).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW S. GART can be reached on (571)272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. U./
Examiner, Art Unit 3687

/Matthew S Gart/
Supervisory Patent Examiner, Art Unit 3687